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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,340	08/06/2001	Stephane Bejanin	91.US2.REG	6695

23557 7590 09/15/2003
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EXAMINER

LY, CHEYNE D

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/924,340

Applicant(s)

BEJANIN ET AL.

Examiner

Cheyenne D Ly

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 14-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 14-18 and 20, drawn to a polynucleotide, vector, and host cell, classified in classes 536 and 435, subclass 23.1; and 320.1, 325, and 252.3.
 - II. Claim 19, drawn to a non-human transgenic animal, classified in class 800, subclass 13.
 - III. Claims 21-24, drawn to a polypeptide, classified in class 530, subclass 350.
 - IV. Claims 25 and 26, drawn to a method of making a vCOL16A1 polypeptide, classified in class 435, subclass 69.1.
 - V. Claim 27, drawn to an antibody, classified in class 530, subclass 387.1.
 - VI. Claim 28, drawn to a method of binding the polypeptide to the antibody, classified in class 435, subclass 5.
 - VII. Claims 29-31, drawn to a method of determining whether a vCOL16A1 gene is expressed within a mammal, classified in class 435, subclass 6.
 - VIII. Claims 32 and 33, drawn to a method of identifying a modulator of vCOL16A1 polypeptide, classified in class 435, subclass 5.
2. The inventions of Groups [I, IV, VII]; II; [III, VI, VIII], and V are distinct inventions because they are directed to different chemical types or methods regarding the critical limitations therein. For Group I, IV, VII, the critical feature is a polynucleotide. For Group II, the critical feature is a non-human transgenic animal. For Group III, VI, VIII, the critical feature is

polypeptide. For Group V, the critical feature is an antibody. The completely distinct critical features of each Group support the undue search burden if they were examined together.

3. Inventions in Groups I, IV, and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant application, the nucleic acid molecule of Group I may be utilized in the distinct usages as needed in Group IV, a method of making a vCOL16A1 polypeptide. As needed in Group VII, a method of determining whether a vCOL16A1 gene is expressed within a mammal, or alternatively, as an antisense therapy. All of these usages are distinct as requiring distinct and different functions and results thereof without overlapping search due to different subject matter. This lack of overlapping searches documents the undue search burden if they were search together.

4. Inventions in Groups III, VI, and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant application, the polypeptide of Group III may be utilized in the distinct usages as needed in Group VI, a method of binding the polypeptide to the antibody. As needed in Group VIII, a method of identifying a modulator of vCOL16A1 polypeptide, or alternatively, a polypeptide may be used in a method for determining the degree of affinity between a ligand and its respective receptor in competitive binding assays, for

example. All of these usages are distinct as requiring distinct and different functions and results thereof without overlapping search due to different subject matter. This lack of overlapping searches documents the undue search burden if they were search together.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

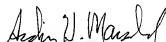
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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (703) 308-3880. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

11. Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

C. Dune Ly
9/11/03


ARDIN H. MARSCHEL
PRIMARY EXAMINER